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EXAMINER

GREENE, DANIEL L

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/648,102

Applicant(s)

COOPER, JONATHAN D.

Examiner

Daniel L. Greene

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27,36-45,47,48 and 50-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27,36-45,47,48,50-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

5. The affidavit under 37 CFR 1.132 filed 3/16/2005 is insufficient to overcome the rejection of claims 1-27, 36-45, 47, 48 and 50-58 based upon Downing et al, U.S. Patent No. 5,963,647 in view of Picciallo, U.S. Patent No. 6,044,360 and Walker et al, U.S. Patent No. 6,193,155 B1 as set forth in the last Office action because:

6. An applicant who is asserting commercial success to support its contention of nonobviousness bears the burden of proof of establishing a nexus between the claimed invention and evidence of commercial success.

The Federal Circuit has acknowledged that applicant bears the burden of establishing nexus, stating:

In the ex parte process of examining a patent application, however, the PTO lacks the means or resources to gather evidence, which supports or refutes the applicant's assertion that the sales constitute commercial success. C.f. Ex parte Remark, 15 USPQ2d 1498, 1503 (Bd. Pat. App. & Int. 1990)(evidentiary routine of shifting burdens in civil proceedings inappropriate in ex parte prosecution proceedings because examiner has no available means for adducing evidence). Consequently, the PTO must rely upon the applicant to provide hard evidence of commercial success.

In re Huang, 100 F.3d 135, 139-40, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996). See also In re GPAC, 57 F.3d 1573, 1580, 35 USPQ2d 1116, 1121 (Fed. Cir. 1995); In re Paulsen, 30 F.3d 1475, 1482, 31 USPQ2d 1671, 1676 (Fed. Cir. 1994) (Evidence of

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commercial success of articles not covered by the claims subject to the 35 U.S.C. 103 rejections was not probative of nonobviousness).

The term “nexus” designates a factually and legally sufficient connection between the evidence of commercial success and the claimed invention so that the evidence is of probative value in the determination of nonobviousness. *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir. 1988)..

An affidavit or declaration attributing commercial success to a product or process “constructed according to the disclosure and claims of [the] patent application” or other equivalent language does not establish a nexus between the claimed invention and the commercial success because there is no evidence that the product or process which has been sold corresponds to the claimed invention, or that whatever commercial success may have occurred is attributable to the product or process defined by the claims. *Ex parte Standish*, 10 USPQ2d 1454, 1458 (Bd. Pat. App. & Inter. 1988).

In considering evidence of commercial success, care should be taken to determine that the commercial success alleged is directly derived from the invention claimed, in a marketplace where the consumer is free to choose on the basis of objective principles, and that such success is not the result of heavy promotion or advertising, shift in advertising, consumption by purchasers normally tied to applicant or assignee, or other business events extraneous to the merits of the claimed invention, etc. *In re Mageli*, 470 F.2d 1380, 176 USPQ 305 (CCPA 1973) (conclusory statements or opinions that increased sales were due to the merits of the invention are entitled to little weight); *In re Noznick*, 478 F.2d 1260, 178 USPQ 43 (CCPA 1973).

In ex parte proceedings before the Patent and Trademark Office, an applicant must show that the claimed features were responsible for the commercial success of an article if the evidence of nonobviousness is to be accorded substantial weight. See *In re Huang*, 100 F.3d 135, 140, 40 USPQ2d 1685, 1690 (Fed. Cir. 1996) (Inventor's opinion as to the purchaser's reason for buying the product is insufficient to demonstrate a nexus between the sales and the claimed invention.). Merely showing that there was commercial success of an article, which embodied the invention, is not sufficient. Ex parte Remark, 15 USPQ2d 1498, 1502-02 (Bd. Pat. App. & Inter. 1990). Compare *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir. 1988) (In civil litigation, a patentee does not have to prove that the commercial success is not due to other factors. "A requirement for proof of the negative of all imaginable contributing factors would be unfairly burdensome, and contrary to the ordinary rules of evidence."). See also *Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309, 227 USPQ 766 (Fed. Cir. 1985) (commercial success may have been attributable to extensive advertising and position as a market leader before the introduction of the patented product); *In re Fielder*, 471 F.2d 690, 176 USPQ 300 (CCPA 1973) (success of invention could be due to recent changes in related technology or consumer demand; here success of claimed voting ballot could be due to the contemporary drive toward greater use of automated data processing techniques); *EWP Corp. v. Reliance Universal, Inc.*, 755 F.2d 898, 225 USPQ 20 (Fed. Cir. 1985) (evidence of licensing is a secondary consideration, which must be carefully appraised as to its evidentiary value

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because licensing programs may succeed for reasons unrelated to the unobviousness of the product or process, e.g., license is mutually beneficial or less expensive than defending infringement suits); *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (Fed. Cir. 1986) (Evidence of commercial success supported a conclusion of nonobviousness of claims to an immunometric "sandwich" assay with monoclonal antibodies. Patentee's assays became a market leader with 25% of the market within a few years. Evidence of advertising did not show absence of a nexus between commercial success and the merits of the claimed invention because spending 25-35% of sales on marketing was not inordinate (mature companies spent 17-32% of sales in this market), and advertising served primarily to make industry aware of the product because this is not kind of merchandise that can be sold by advertising Hyperbole.).

Establishing long-felt need requires objective evidence that an art recognized problem existed in the art for a long period of time without solution. The relevance of long-felt need and the failure of others to the issue of obviousness depends on several factors.

First, the need must have been a persistent one that was recognized by those of ordinary skill in the art. In *re Gershon*, 372 F.2d 535, 539, 152 USPQ 602, 605 (CCPA 1967) ("Since the alleged problem in this case was first recognized by appellants, and others apparently have not yet become aware of its existence, it goes without saying that there could not possibly be any evidence of either a long felt need in the . . . art for a solution to a problem of dubious existence or failure of others skilled in the art who

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unsuccessfully attempted to solve a problem of which they were not aware.");
Orthopedic Equipment Co., Inc. v. All Orthopedic Appliances, Inc., 707 F.2d 1376,
217 USPQ 1281 (Fed. Cir. 1983) (Although the claimed invention achieved the
desirable result of reducing inventories, there was no evidence of any prior
unsuccessful attempts to do so.).

Second, the long-felt need must not have been satisfied by another before the
invention by applicant. Newell Companies v. Kenney Mfg. Co., 864 F.2d 757, 768, 9
USPQ2d 1417, 1426 (Fed. Cir. 1988) (Although at one time there was a long-felt need
for a "do-it-yourself" window shade material which was adjustable without the use of
tools, a prior art product fulfilled the need by using a scored plastic material which could
be torn. "[Once another supplied the key element, there was no long-felt need or,
indeed, a problem to be solved".)

Third, the invention must in fact satisfy the long-felt need. In re Cavanagh, 436
F.2d 491, 168 USPQ 466 (CCPA 1971).

Every patent is presumed valid (35 U.S.C. 282), and that presumption includes
the presumption of operability (Metropolitan Eng. Co. v. Coe, 78 F.2d 199, 25 USPQ
216 (D.C.Cir. 1935). Affidavits or declarations attacking the operability of a patent cited
as a reference must rebut the presumption of operability by a preponderance of the
evidence. In re Sasse, 629 F.2d 675, 207 USPQ 107 (CCPA 1980).

Further, since in a patent it is presumed that a process if used by one skilled in
the art will produce the product or result described therein, such presumption is not
overcome by a mere showing that it is possible to operate within the disclosure without

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obtaining the alleged product. In re Weber, 405 F.2d 1403, 160 USPQ 549 (CCPA 1969). It is to be presumed also that skilled workers would as a matter of course, if they do not immediately obtain desired results, make certain experiments and adaptations, within the skill of the competent worker. The failures of experimenters who have no interest in succeeding should not be accorded great weight. In re Michalek, 162 F.2d 229, 74 USPQ 107 (CCPA 1947); In re Reid, 179 F.2d 998, 84 USPQ 478 (CCPA 1950).

Where the affidavit or declaration presented asserts inoperability in features of the reference, which are not relied upon, the reference is still effective as to other features, which are operative. In re Shepherd, 172 F.2d 560, 80 USPQ 495 (CCPA 1949). Where the affidavit or declaration presented asserts that the reference relied upon is inoperative, the claims represented by applicant must distinguish from the alleged inoperative reference disclosure. In re Crosby, 157 F.2d 198, 71 USPQ 73 (CCPA 1946). See also In re Epstein, 32 F.3d 1559, 31 USPQ2d 1817 (Fed. Cir. 1994) (lack of diagrams, flow charts, and other details in the prior art references did not render them nonenabling in view of the fact that applicant's own specification failed to provide such detailed information, and that one skilled in the art would have known how to implement the features of the references).

If a patent teaches or suggests the claimed invention, an affidavit or declaration by patentee that he or she did not intend the disclosed invention to be used as claimed by applicant is immaterial. In re Pio, 217 F.2d 956, 104 USPQ 177 (CCPA 1954).

Compare In re Yale, 434 F.2d 66, 168 USPQ 46 (CCPA 1970) (Correspondence from a

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co-author of a literature article confirming that the article misidentified a compound through a typographical error that would have been obvious to one of ordinary skill in the art was persuasive evidence that the erroneously typed compound was not put in the possession of the public.).

The affidavit discloses in paragraph 18, " In just the first six months of 2004, the SafeSend service grew by 1500 percent ...". The Applicant does not provide any facts that would explain the alleged growth. In addition, a publication by the provider of a system on the growth of their system without facts and figures that explain why there was growth, as previously stated, does not merit consideration.

Status of Claims

1. Claims 1-27, 36-45, 47-48 and 50-58 remain pending and are again presented for examination.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 1-13, 15-27, 36-45, 47-48 and 54-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downing et al, U.S. Patent No. 5,963,647 in view of Picciallo, U.S. Patent No. 6,044,360.

As per **Claims 1, 5 and 38**, Downing discloses a computer system to facilitate secure money transfer transactions between sender consumers and recipient consumers, said computer system comprising:

- a transaction control center for receiving information from a sender consumer in order to initiate a secure money transfer with a recipient consumer (Figures 2-3; Col. 5, lines 47-60; Col. 6, lines 18-30);

- a transaction database configured to store transaction data associated with said secure money transfer, said transaction data associated with said secure money transfer including consumer transaction information, a recipient address, and a unique security identifier for said secure money transfer, said transaction database being in communication with said transaction control center (Col. 5, lines 60-65; Col. 6, lines 50-65; Col. 8 line 35-Col. 9 line 20); and

- a transaction fulfillment center being in communication with said transaction control center, said transaction fulfillment center utilized by said recipient consumer to complete said secure money transfer (Col. 7, lines 18-28).

Downing, however, fails to explicitly disclose the use of a computer readable medium configured to enable the completion of the secure money transfer when utilized by a recipient consumer. Picciallo discloses a third party credit card method wherein an account holder can initiate a transfer of funds to a recipient and further teaches that a computer readable medium is configured to enable the completion of the secure money transfer (Col. 3, lines 14-20; Col. 9, lines 8-14 and wherein the computer readable

medium is either issued to the account holder for delivery to the third party recipient or it may be issued directly to the third party recipient (Col. 11, lines 35-45). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Downing and incorporate the ability to configure a computer readable medium to enable the money transfer and further delivering the computer readable medium directly to either the sender or the recipient as taught by Picciallo, or even to a third party for pickup by the recipient, thereby providing a convenient means by which the distribution of the card and its usage can be controlled by the sender. It also would have been obvious to one having ordinary skill in the art to utilize a computer readable medium such as a credit/ATM card since these mediums are so well known and devices that accept these forms of mediums are also readily available in virtually any location.

As per **Claims 2-4**, Downing further discloses wherein the transaction control center includes a telemarketing operation capable of receiving a secure money transfer telephone order from said sender consumer or a web site available on the Internet, or by using an ATM (Figure 2; Figure 5, lines 23-46).

As per **Claims 6, 10-11 and 40-43**, Downing further disclose the use of one or more of a network of third party commercial vendors who have devices such as ATM with dedicated communication systems that are always available for fulfilling the money transfer (Figure 2; Col. 5, lines 23-46).

As per **Claims 7-8**, Downing and Picciallo fail to explicitly disclose activation of the computer readable medium through the use of toll free telephone lines or via Internet communications. Examiner takes Official Notice that activating credit/debit/ATM cards through various means was well known in the art at the time of applicant's claimed invention and it would have been obvious to enable the activation of these cards through these means in order to provide additional security measures. As was well known in the art, this feature would prevent the unauthorized use of a lost or stolen card by an unauthorized person.

As per **Claims 9 and 39**, Downing fails to disclose the use of a computer readable medium or storing a pre-assigned serial number associated with consumer transaction information. Picciallo discloses the use of a computer readable medium as well as an identifier encoded on the magnetic card, which is associated with the transaction information (Col. 11, lines 35-40). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Downing and use a computer readable medium encoded with an identifier such as a pre-assigned serial number as taught by Picciallo in order to link the card to a particular transaction or account.

As per **Claims 12-13, 16-19 and 44-45**, Downing discloses a computer implemented method for facilitating a secure money transfer transaction between a

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sender consumer and a recipient consumer, said computer implemented method comprising the steps of:

- a) obtaining transaction payment information associated with said sender consumer (Figures 2-3; Col. 6, lines 18-30);
- b) obtaining address information for said recipient consumer (Col. 6, lines 25-30);
- c) defining a unique security identifier associated with said secure money transfer (Col. 6, lines 20-25);
- d) entering the information in steps a-c) into the transaction database (Col. 5, lines 60-65; Col. 6, lines 50-65; Col. 8 line 35-Col. 9-line 20)
- e) assigning a serial number to the consumer transaction and information (Figure 4; Col. 6, lines 60-65);
- g) providing said recipient consumer with said unique security identifier (Col. 7, lines 6-18) and;
- i) enabling the recipient consumer to withdraw cash from financial networks using the unique security identifier (Col. 7, lines 18-28; Col. 12, lines 10-45).

Downing, however, fails to explicitly disclose configuring a magnetically encoded computer readable medium to said secure money transfer, providing the medium to the recipient said computer readable medium utilized by said recipient consumer in completing said secure money transfer. Picciallo discloses a third party credit card method wherein an account holder can initiate a transfer of funds to a recipient and further teaches that a computer readable medium is configured to enable the completion of the secure money transfer (Col. 3, lines 14-20; Col. 9, lines 8-14) and

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wherein the computer readable medium is either issued to the account holder for delivery to the third party recipient or it may be issued directly to the third party recipient (Col. 11, lines 35-45). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Downing and incorporate the ability to configure a computer readable medium to enable the money transfer and further delivering the computer readable medium directly to either the sender or the recipient as taught by Picciallo, or even to a third party for pickup by the recipient thereby providing a convenient means by which the distribution of the card and its usage can be controlled by the sender. It also would have been obvious to one having ordinary skill in the art to utilize a computer readable medium such as a credit/ATM card since these mediums are so well known and devices that accept these forms of mediums are also readily available in virtually any location.

As per **Claim 15**, Downing further discloses a computer implemented method as recited in claim 12, wherein the said act of facilitating the withdrawal of cash by a recipient consumer configured computer readable medium further comprises the acts of:

(a) entering the recipient consumer request into a transaction database, which may include a serial number for a configured computer readable medium (Col. 12, lines 19-26).

(b) comparing the recipient consumer information with the stored consumer transaction data to determine if the recipient consumer information matches the consumer transaction information and if it is valid (Col. 12, lines 19-55);

(c) if there is a match, then the transaction database associates the recipient consumer information with the consumer transaction data, records the transaction, and signals a financial network that the configured computer readable medium is enabled to withdraw cash from ATM networks (Col. 12, lines 19-55); and

(d) if there is not a match the consumer transaction information then the transaction database requests new information from the recipient consumer in step a. (Col. 12, lines 23-38)

Again, Downing fails to explicitly disclose the use of a computer readable medium, however, this is addressed above.

As per **Claims 20-21 and 24-27**, Downing and Picciallo fail to explicitly disclose activation of the computer readable medium through the use of toll free telephone lines or via Internet communications. Examiner takes Official Notice that activating credit/debit/ATM cards through various means was well known in the art at the time of applicant's claimed invention and it would have been obvious to enable the activation of these cards through these means in order to provide additional security measures. As was well known in the art, this feature would prevent the unauthorized use of a lost or stolen card by an unauthorized person.

As per **Claims 22-23**, Downing further discloses wherein the unique security identifier is provided by the sender consumer (Col. 6, lines 20-27; Col. 7, lines 7-12).

As per **Claims 36-37**, Downing further discloses a computer implemented method as recited in claim 12, wherein the said act of activating of cash by a recipient consumer configured computer readable medium further comprises the acts of:

- (a) entering the recipient consumer request into a transaction database, which may include a serial number (Col. 12, lines 19-26).
 - (b) determining the validity of the activation request (Col. 12, lines 19-55);
 - (c) if the activation is valid, then the transaction database signals a financial network that the configured computer readable medium is active (Col. 12, lines 19-55);
- and
- (d) if the activation is not valid, then the transaction database requests new information from the recipient consumer (Col. 12, lines 23-38)

Again, Downing fails to explicitly disclose the use of a computer readable medium, however, this is addressed above.

As per **Claims 47-48**, Downing discloses an automated process for sending money from a first location to a second location comprising:

- a) receiving a request for a secure money transfer from a requestor (Col. 6, lines 18-30);

b) receiving information associated with a recipient for the secure money transfer including an amount of the money transfer (Col. 6, lines 18-30);

d) assigning an authorization to the secure money transfer for using the secure money transfer instrument in automated teller machines wherein the authorization includes an access code in order to receive money at the ATM (Col. 6, lines 20-30; Col. 7, lines 18-28; Col. 12, lines 10-45);

e) wherein the secure money transfer is used to transfer money from a requestor located in a first country to a recipient located in a second country, and wherein

Downing, however, fails to explicitly disclose transferring the amount to a secure money transfer instrument, providing the medium to the recipient said computer readable medium utilized by said recipient consumer in completing said secure money transfer. Picciallo discloses a third party credit card method wherein an account holder can initiate a transfer of funds to a recipient and further teaches that a computer readable medium is configured to enable the completion of the secure money transfer (Col. 3, lines 14-20; Col. 9, lines 8-14) and wherein the computer readable medium is either issued to the account holder for delivery to the third party recipient or it may be issued directly to the third party recipient (Col. 11, lines 35-45). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Downing and incorporate the ability to configure a computer readable medium to enable the money transfer and further delivering the computer readable medium directly to either the sender or the recipient as taught by Picciallo, or even to a third party for pickup by the recipient thereby providing a convenient means by which

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the distribution of the card and its usage can be controlled by the sender. It also would have been obvious to one having ordinary skill in the art to utilize a computer readable medium such as a credit/ATM card since these mediums are so well known and devices that accept these forms of mediums are also readily available in virtually any location.

As per **Claims 54-55**, Downing discloses an automatic money transfer system for transferring money from a donor to a donee comprising:

a) an automated server system for facilitating the secure transfer of money from a donor to a donee, the automated server system being operative to allocate funds for secure transfer and to assign a security code (Col. 6, lines 18-30);

b) a data storage device for recording the secure transfer (Col. 5, lines 60-65; Col. 6, lines 50-65; Col. 8 line 35-Col. 9 line 20);

c) enabling the donee to access the funds from an ATM using the security code (Col. 7, lines 18-28; Col. 12, lines 10-45).

Downing, however, fails to explicitly disclose allocating funds to a portable secure transfer instrument including machine-readable information, providing the instrument to the recipient enabling said recipient consumer to complete said secure money transfer. Picciallo discloses a third party credit card method wherein an account holder can initiate a transfer of funds to a recipient and further teaches that a computer readable medium is configured to enable the completion of the secure money transfer (Col. 3, lines 14-20; Col. 9, lines 8-14) and wherein the computer readable medium is either issued to the account holder for delivery to the third party recipient or it may be issued

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directly to the third party recipient (Col. 11, lines 35-45). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Downing and incorporate the ability to configure a computer readable medium to enable the money transfer and further delivering the computer readable medium directly to either the sender or the recipient as taught by Picciallo, or even to a third party for pickup by the recipient thereby providing a convenient means by which the distribution of the card and its usage can be controlled by the sender. It also would have been obvious to one having ordinary skill in the art to utilize a computer readable medium such as a credit/ATM card since these mediums are so well known and devices that accept these forms of mediums are also readily available in virtually any location.

As per **Claim 56**, Downing further discloses wherein the security code must be manually entered on the ATM by the donee or recipient to receive money (Col. 12, lines 17-23).

As per **Claim 57**, Downing fails to further disclose using an automated communications system for providing the security code to the donee. Downing, however, does disclose that the sender is responsible for contacting the recipient and providing the secret code to the recipient as well as other information. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention that the sender may use any communication means available in order to convey this

information to the recipient, including an automated communications system such as e-mail as a matter of convenience.

As per **Claim 58**, Downing further discloses wherein the amount is provided by the requestor in a first currency and provided to the recipient in second currency, wherein the first currency and the second currency are of different nationalities (Col. 7, lines 44-67).

12. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Downing, U.S. Patent No. 5,963,647 and Picciallo, U.S. Patent No. 6,044,360, and applied above and further in view of Hall et al, U.S. Patent No. 6,026,375.

As per **Claim 14**, Downing and Picciallo fail to specifically disclose wherein the act of determining contact information for the recipient includes the act of selecting the most appropriate delivery location by implementing an algorithm that returns the most appropriate delivery location based on criteria, comprising but not limited to: (a) the geographic location of recipient, (b) the desired hours of pick-up location, and (c) the desired features of pick-up location. Hall discloses a method for processing orders from customers and teaches that the system will determine the customer's location and further determine, based on the customer's location, a local facility that can satisfy the customer's order. The service then transmits the order to the local facility and schedules the fulfillment of the order to coincide with the customer's arrival at the local

facility (Abstract). Thus, Hall discloses an algorithm that returns the most appropriate delivery location based on certain consumer information or criteria. Examiner submits that it would have been obvious to modify the methods of Downing and Picciallo and incorporate the ability to determine an appropriate delivery location based on certain consumer criteria in view of this teaching by Hall to enable a flexible and more convenient means for delivering the item to the consumer. The motivation would be to provide additional conveniences to the recipient so that he/she does not have to travel long distances to receive the item or can receive the item at any time of day.

13. Claims 50-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downing, U.S. Patent No. 5,963,647 and Picciallo, U.S. Patent No. 6,044,360, and applied above and further in view of Corder et al, U.S. Patent No. 5,936,221.

As per Claim 50,

a) receiving a request for a secure money transfer from a requestor (Col. 6, lines 18-30);

b) receiving information associated with a recipient for the secure money transfer including an amount of the money transfer (Col. 6, lines 18-30);

d) assigning an authorization to the secure money transfer for using the secure money transfer instrument in automated teller machines wherein the authorization includes an access code in order to receive money at the ATM (Col. 6, lines 20-30; Col. 7, lines 18-28; Col. 12, lines 10-45);

e) wherein the secure money transfer is used to transfer money from a requestor located in a first country to a recipient located in a second country (Col. 7, lines 29-67).

Downing, however, fails to explicitly disclose transferring the amount to a secure money transfer instrument, providing the medium to the recipient said computer readable medium utilized by said recipient consumer in completing said secure money transfer. Picciallo discloses a third party credit card method wherein an account holder can initiate a transfer of funds to a recipient and further teaches that a computer readable medium is configured to enable the completion of the secure money transfer (Col. 3, lines 14-20; Col. 9, lines 8-14) and wherein the computer readable medium is either issued to the account holder for delivery to the third party recipient or it may be issued directly to the third party recipient (Col. 11, lines 35-45). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Downing and incorporate the ability to configure a computer readable medium to enable the money transfer and further delivering the computer readable medium directly to either the sender or the recipient as taught by Picciallo, or even to a third party for pickup by the recipient thereby providing a convenient means by which the distribution of the card and its usage can be controlled by the sender. It also would have been obvious to one having ordinary skill in the art to utilize a computer readable medium such as a credit/ATM card since these mediums are so well known and devices that accept these forms of mediums are also readily available in virtually any location.

Downing further discloses wherein the secure money transfer is used to transfer money from the requester located in a first country to a recipient located in a second

country as described above. Although it may have been obvious that the requestor may be capable of adding additional funds to the secure money transfer using the process as disclosed by Downing, this is not explicitly disclosed. Corder et al disclose a system and method for transferring value to a card and further disclose that additional funds may be added and transferred to the card via a communications network (Col. 2, lines 20-39). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Downing and include the ability to add additional funds to the secure money transfer to provide a convenient method for the recipient to have access to additional funds when the original transfer amount is depleted.

As per **Claims 51-53**, March discloses an automated process for sending money from a first location to a second location comprising:

a) receiving a request for a secure money transfer from a requestor indicating a destination for the transfer and an amount for the transfer via a communications network (Col. 6, lines 18-30; Col. 7, lines 29-67);

b) assigning an authorization code to the ATM card (Col. 6, lines 20-30; Col. 7, lines 18-28; Col. 12, lines 10-45); and

Downing, however, fails to explicitly disclose transferring the amount to an ATM card, providing the card to the recipient and said card utilized by said recipient consumer in completing said secure money transfer. Picciallo discloses a third party credit card/ATM card method wherein an account holder can initiate a transfer of funds

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to a recipient and further teaches that a computer readable medium is configured to enable the completion of the secure money transfer (Col. 3, lines 14-20; Col. 9, lines 8-14) and wherein the computer readable medium is either issued to the account holder for delivery to the third party recipient or it may be issued directly to the third party recipient (Col. 11, lines 35-45). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Downing and incorporate the ability to configure a computer readable medium to enable the money transfer and further delivering the computer readable medium directly to either the sender or the recipient as taught by Picciallo, or even to a third party for pickup by the recipient thereby providing a convenient means by which the distribution of the card and its usage can be controlled by the sender. It also would have been obvious to one having ordinary skill in the art to utilize a computer readable medium such as a credit/ATM card since these mediums are so well known and devices that accept these forms of mediums are also readily available in virtually any location.

Although it may have been obvious that the requestor may be capable of adding additional funds to the secure money transfer using the process as disclosed by Downing, this is not explicitly disclosed. Corder et al disclose a system and method for transferring value to a card and further disclose that additional funds may be added and transferred to the card via a communications network (Col. 2, lines 20-39). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Downing and include the ability to add additional funds to the

secure money transfer to provide a convenient method for the recipient to have access to additional funds when the original transfer amount is depleted.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. **Examiner's Note:** Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part

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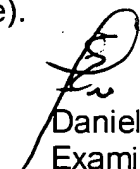
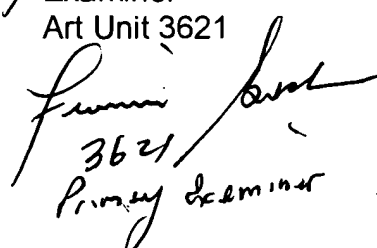
of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene whose telephone number is 571-272-6707. The examiner can normally be reached on M-Thur. 8am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

7/21/2005


Daniel L. Greene
Examiner
Art Unit 3621

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Primary Examiner